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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,934	02/13/2001	Natwar Modani	JP920000227US1	1660

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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,934

Applicant(s)

MODANI ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/15/01
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

1. This Office Action is in response to the original application. Claims 1-13 are now pending. Claims 1,10, 13 are independent.

Claim Rejections - 35 USC § 102

2.The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

a. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3.Claims 1-3, 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Palmer et al., US 6505,773 B1.

As to claims 1, and 13, Palmer discloses a method and e-commerce system for the honoring of electronic coupons utilizing computing equipment, comprising the steps of:

- (a) an issuing party issuing an electronic coupon to a customer;
- (b) said customer presenting said coupon for redemption to a redemption party;

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c) said redemption party transmitting said coupon to an authentication party (remote database server) for authentication (see at least abstract; Fig. 8 and associated text).

As to the following steps

“(d) if authentic, said authentication party charging said redemption party a fee and passing that fee to said issuing party; and

(e) said redemption party honoring said coupon for said customer and seeking reimbursement of said fee from said issuing party”.

the "if" in step (d) means that nothing happens if the coupon is invalid. The method does not require a valid coupon. The method does not loop back until a valid coupon is handled. In other words, the limitations of the claim appear to be issuing a coupon, presenting it for redemption, transmitting it for authentication, failing authentication and stopping, never moving any fees anywhere.

This is because method claims are a series of steps that are actually performed not a protocol or plan of all possible steps theoretically performed. "If" becomes like "or" in structure claims. Thus claim 1 is interpreted as going down one path or the other path but not physically doing both.

(see Cochrane v. Deener, 94 U.S. 780, 24 L.Ed. 138, 141 (1876), where the Supreme Court held: "A process is a mode of treatment of certain materials to produce a certain result. It is an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing." (emphasis added). Thus processes must be physically performed, not hypothetical acts that need not be performed. Thus alternatives that are not required to be performed aren't an act or series of acts of actually doing something.

Here, it is interpreted the authentication fails, thus steps d) and e) need not be addressed.

As to claim 2, Palmer discloses

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the further step, after step (b), of

(f) said redemption party verifying validity of said coupon with said issuing party (see at least abstract; Fig. 8, item 730, and associated text).

As to claim 3, Palmer discloses the validity of a coupon is established by an electronic signature (Fig. 8, item 730, and associated text).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4- 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer as applied to claims 1-2 above, and further in view of Scroggie et al., US 6,185,541 B1.

As to claim 4 (dependent on claim 2), Official Notice is taken that validity of a coupon established by an electronic signature which is achieved by public key cryptography is well-known and thus obvious to be added to Palmer's encrypted coupons to increase the security thereof.

As to claim 5 (dependent on claim 1), it is interpreted that the authentication party and the issuing party are the same as allowed by the specifications.

Further, Palmer does not specifically disclose the authentication/issuer party issuing a plurality of blank said coupons to itself for subsequent use. However in the same coupon art, Scroggie discloses coupons templates used by the issuer to generate unique coupon indicia, send

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the coupon to the user computer for printing or for display to user then e-redeeming (see at least Fig. 11, 12 and associated text). It would have been obvious to one skilled in the art at the time the invention was made to add Scroggie to Palmer to generate unique better-targeted coupons for the users.

As to claim 6 (dependent on claim 5) Scroggie discloses
wherein said coupons include variable fields (see at least Fig. 11 and associated text)

As to “that are generated by one-way hash functions”. This is a product by process situation where the product claimed is the coupons with variable fields. The process here is not given weight to.

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable, even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

As to claims 7-9, involving steps d) and e), no consideration is given thereto as claim d) is not given weight to as explained in claim 1, above.

As to claim 10, Scroggie discloses an electronic coupon, having a plurality of data fields, including: a coupon identifier, x; and two other fields (see at least Figs. 11, 12 and associated text)

As to first one-way hash function field, $f(x)$; and a secure signature field including a secure second one-way hash function, $g(x)$, those data in the fields, as claimed, are non-functional data as nothing is done to those data.

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Scroggie may not teach the specific data in the coupon fields recited in the claimed invention. However, the specific meaning/interpretation of the data in the coupon fields does not patentably distinguish the claimed invention, a coupon. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of data in the coupon fields in the system taught by Scroggie because the subjective interpretation of the data in the coupon fields does not patentably distinguish the claimed invention: a coupon.

As to claim 11 (dependent on claim 10) “said secure signature field comprises an information field for information” is non-functional data as noted above and patentability does not hinge thereon.

As to “manufactured by a centralized coupon issuer and authentication”, this phrase is not given weight to because it is a process in a product by process claim. See MPEP 2113.

As to claim 12 (dependent on claim 10) Scroggie discloses customizable information field for information (see at least Figs. 11-12 and associated text). As to “maintained by a centralized coupon issuer and authenticator”, this part of the claim is ignored per MPEP 2113 (see rationale in claims 6, 11 above).

Conclusion

6. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Thursday 9:00-6:00.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113

June 25, 2004



KHL



JAMES W. MYHRE
PRIMARY EXAMINER